REMARKS/ARGUMENTS

Overview of the Office Action

Claims 1-13, 21 and 23 have been rejected under 35 USC 101 for being directed to non-statutory subject matter.

Claims 1, 2, 14, 15, 21, 22 and 23 have been provisionally rejected on nonstatutory double patenting over claims 1 and 2 of copending patent application no. 10/080,949.

Claims 1-9, 12, 14-19, 21, 22 and 23 have been rejected under 35 USC §103(a) as unpatentable over U.S. Patent No. 5,287,181 (Holman) (USP 5,287,181) in view of U.S. Patent Appl. Pub. No. 2003/0110078 (Chang) and U.S. Patent No. 7,302,696 (Yamamoto).

Claims 10, 11 and 20 have been rejected under 35 USC §103(a) as unpatentable over Holman, Chang and Yamamoto, and further in view of U.S. Patent Appl. Pub. No. 2003/0014748 (Ben-David).

Status of the claims

No claim has been amended.

Claim 23 has been canceled.

Claim 1-22 remain pending

Rejection of Claims under 35 USC 101

Claims 1-13 and 21 have been rejected as directed to non-statutory subject matter because they "refer to a method without an association to a statutory system or apparatus." This rejection is incomprehensible to the undersigned because claim 1 explicitly refers to, inter alia, "a program signal source", "reproduction equipment", and "portable storage media". Claim 21

contains similar features. Withdrawal of this rejection is clearly in order.

Claim 23 has been rejected as directed to non-statutory subject matter because it refers to a signal. This claim has been canceled, without prejudice.

Rejection of claims under the doctrine of obviousness-type double patenting

The Office Action states that claims 1, 2, 14, 15, 21, 22, and 23 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending patent application no. 10/080,949.

Patent application no. 10/080,949 has been abandoned.

Summary of subject matter disclosed in the specification

The following descriptive details are based on the specification. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations, which are unclaimed.

Disclosed is an interactive method for generating a supplementary, program-related output. The disclosed method includes obtaining a programming signal, obtaining a supplementary, program-related data signal, combining the programming signal and the supplementary, program-related data signal into a broadcast signal, broadcasting the broadcast signal from a program signal source; receiving the broadcast signal, performing the programming signal of the received broadcast signal with reproduction equipment for an audience, generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal, storing the supplementary, program-related data signal of the received broadcast signal on a portable storage media, enabling retrieval of rewards

data corresponding to products or services by accessing the stored supplementary, program-related data signal from the portable storage media, and selecting a reward from the retrieved rewards data.

Descriptive summary of Holman

Holman discloses an electronic redeemable coupon generating system. The system of Holman includes an encoder for encoding coupon-related data in a television signal transmission, a decoder for receiving the television signal transmission and extracting the coupon-related data therefrom, and a recording device for recording the extracted coupon-related data on a recording medium for subsequent readout and redemption. The decoder of Holman includes a display driver for displaying indicia on a television monitor screen responsive to coupon-related data encoded in the television signal transmission. Upon observing the indicia on the television monitor screen, the user of the system of Holman can manually and selectively extract the coupon-related data from the television signal transmission. After an optional editing function, the extracted coupon-related data of Holman is stored on a recording medium such as a magnetically striped card. The decoder of Holman may be part of the standard circuitry of a closed-caption adapted or modified television set (see Abstract of Holman).

Descriptive summary of Chang

Chang discloses a system and method for broadcast advertising. The system of Chang includes a broadcast receiver that receives a broadcast signal. In addition to the usual video and/or audio data, the broadcast signal of Chang includes embedded product or service data. The broadcast receiver of Chang includes a memory slot that is sized and shaped to receive a portable

memory media. In response to a signal received at the broadcast receiver, e.g., from a remote control unit, the embedded product data of Chang is extracted from the broadcast signal and downloaded to the portable memory media forming a virtual shopping list. To facilitate shopping, the portable memory media of Chang can then be installed in a shopping computer, e.g., in an information kiosk at a shopping mall to determine where a particular product can be found, how much it costs, etc. (see Abstract of Chang).

Descriptive summary of Yamamoto

Yamamoto discloses a technique to provide an interactive coupon channel available via a video casting system. The user is provided with various options for viewing, obtaining and using coupons. If a user obtains a coupon, then one option that is made possible by this technique is to obtain by email automatic reminders of a coupon's expiration date. This feature is specifically relied on by the Examiner in rejecting the claims, and it can be found in the paragraph bridging columns 8 and 9 of this reference.

Rejection of claims 1-9, 12, 14-19, 21, 22 and 23 under 35 USC §103(a)

The Office Action states that the combination of Holman, Chang and Yamamoto teaches all of Applicants' recited elements.

Independent claim 1 recites an interactive method for generating a supplementary, program-related output, that includes "generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal", which Holman, Chang and Yamamoto, whether taken alone or in combination, fail to teach or suggest.

The Examiner concedes (see middle of page 5 of the Office Action) that Holman and Chang fail to show this feature. However, the Examiner contends that "Yamamoto teaches a method for generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal". However, it is indisputably clear from Yamamoto's explanation in the very paragraph relied on by the Examiner that any audible signal that may be generated is NOT "in response to the received broadcast signal" but, rather, is related to an independently transmitted email that may occur days, weeks or months after such transmission has occurred. the audible signal is related to the expiration date of the coupon, not the broadcast transmission of the supplementary, program-related data signal.

Therefore, Holman, Chang and Yanmamoto, whether taken alone or in combination, fail to teach or suggest, an interactive method for generating a supplementary, program-related output, that includes "generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal", as recited in Applicants' claim 1.

Independent claims 14, 21 and 22 each recite limitations similar to independent claim 1 and are, therefore, deemed to be patentably distinct over Holman, Chang and Yanmamoto for at least those reasons discussed above with respect to independent claim 1.

In view of the foregoing, Applicants submit that Holman, Chang and Yanmamoto, whether taken alone or in combination, fail to teach or suggest the subject matter recited in independent claims 1, 14, 21 and 22. Accordingly, claims 1, 14, 21 and 22 are patentable thereover under 35 U.S.C. §103(a).

Dependent claims

Claims 2-9, 12, and 15-19, which depend from independent claims 1 and 14, incorporate all of the limitations of the respective independent claims and are, therefore, deemed to be patentably distinct over Holman, Chang and Yamamoto for at least those reasons discussed above with respect to independent claims 1 and 14.

Rejection of claims 10, 11, and 20 under 35 USC §103(a)

The Office Action states that the combination of Holman, Chang, Yamamoto and Ben-David teaches all of Applicants' recited elements.

Holman, Chang and Yamamoto have been previously discussed, and clearly they fail to teach or suggest the invention recited in Applicant's independent claims 1 and 14.

Because Holman, Chang and Yamamoto fail to teach or suggest the subject matter recited in independent claims 1 and 14, and because Ben-David does not teach or suggest the recited subject matter of independent claims 1 and 14 that is missing from the other applied references, the addition of Ben-David to the reference combination does not remedy the deficiencies of Holman, Chang and Yamamoto.

Claims 10, 11, and 20, which depend from independent claims 1 and 14, incorporate all of the limitations of the respective independent claims and are, therefore, deemed to be patentably distinct over Holman, Chang, Yamamoto, and Ben-David for at least those reasons discussed above with respect to independent claims 1 and 14.

Conclusion

Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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